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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,838	07/13/2000	Michael S. Battaglia	2694-200	6798

7590 09/28/2004

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/615,838	Applicant(s) BATTAGLIA ET AL.	
	Examiner Vincent F. Boccio	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-93 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/3/04 / 12/10/03 / 6/2/03 / 9/5/02</u> | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-6, 9-10, 12, 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi et al. (US 6,020,982).

Regarding claims 1 and 14-17, 19, Yamauchi discloses and meets the limitations associated with a portable (met by being transportable, from such as a place of purchase, for example) hand held (carried by hand, home from such as from the place of purchase or other), digital transfer and repository device for use with a removable digital module associated with a digital appliance (camera, computer etc.....) and a large capacity storage device comprising:

- a housing of a size to be held in a user's hand (as recited the size is met by either smaller than the hand, as large as a hand or larger than a hand, wherein a hand size is not a fixed size, therefore, met in view of, Fig. 62, wherein in view of the memory module slots, thereby the size is approx. the size of a current day VCR, in view of Fig. 62) and including a memory port sized to receive a digital memory module (two ports 614 & 615), having a plurality of files (met by pictures, having files

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for each picture, generated by the camera of Fig. 2, or other, also reference Fig. 1);

- at least one key for selecting a file from the memory module (Fig. 74, met by a user input a keyboard or a remote with keys, facilitating a transfer from a memory card to the system, Figs. 74-117, etc.....), claims 14-15;
- a display for displaying data related to the file (Fig. 111, status, "reception has started Job has been interrupted", Fig. 115, "COPY, Exchange, Deletion", Fig. 116 A, dates and , also reference other Figures 74-117 and related disclosures, etc.....), or a message and/or data indicative of at least part of the contents of the module (Fig.115, 109 A, 108, 107, 106 etc.....), claims 16-17;
- data processing circuitry (Fig. 74-82) for reading at least one said file stored in the module inserted into the memory port (Fig. 62, ports 614 & 615) and for controlling the transfer (Fig. 75, "Data Transfer Control Circuit" & Fig. 105 A, shows from source card 1 to destination one of card or HDD etc.....) of at least one said file to the large capacity storage device (Fig. 74, such as HD 819 or other storage) and a power source to provide power to at least the digital processor and data transfer circuitry (which is not clearly shown, but, is an inherent feature, as one skilled in the art clearly understands, that the circuitry requires some sort of a power source, to operate {access, provide menus and perform transfers}, as all electrical devices require some sort of power source operate).

The device 600 since can offload a memory card to another for example reads on being a repository device transportable or portable and carry-able, therefore hand carry-able therefore, by one hand or handheld.

Regarding claims 2, 4-6, 9-10, 13, Yamauchi further meets the limitations of a port for connecting to an

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external large capacity digital storage, the port being operatively coupled to the processing circuitry for receiving digital data from the memory module (Figs. 71-82, also reference Fig. 112, card to one of external memory, modem, also Fig. 104 A, "record destination card 1 or 2, HDD or DDD or other, such as a computer or other as shown in Fig. 74),

- at least one host device port (also Fig. 74), claim 4;
- computer ("personal computer or word processor 812"), claim 5;
- camera (Fig. 1, "Elect. Still Camera 11"), claim 6;
- further a device for generating either analog or digital data or uncompressed (such as shown in Fig. 81, digital video device 81 & 816, analog device 815 & 816, further digital provided from digital devices Fig. 74, even uncompressed to be compressed Fig. 75, "625 h", etc.....), claims 9-10.

Regarding claim 12, Yamauchi further meets the limitation of reformatting a module to place the module into a state where it can be re-used (Fig. 107, "deleting data recorded on a card/module, reads on a reformat to a state which it can be reused or offloading means and deleting the contents of the memory card).

Regarding claims 18-19, Yamauchi in Fig. 62, a further memory port or at least 2 (Fig. 62, shows 2, and the claims only requires two, but the disclosure somewhere mentions three), wherein further discloses a HD/HDD {Hard Disk Drive} being a hard drive, being a large capacity digital data storage device (such as shown in Fig. 74, "HD 819").

Regarding claim 20, Yamauchi generates a signal upon the detection and insertion of any memory card (Fig. 62, "display parts 614 A & 615 B, light up", when cards are inserted/detected).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 3, 7-8, 11, 13, 21-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (US 6,020,982).

Regarding claim 3, Yamauchi discloses a large capacity storage device of unit 600, but fails to disclose the large capacity storage being internal.

The examiner takes official notice that internal storage associated with external storage is well known and therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Yamauchi by incorporating at least one large capacity internal storage device, as is well known to those skilled in the art to provide internal as well as external devices.

Regarding claims 7-8, 11 and 31-32, Yamauchi discloses VTRs in Fig. 1 and many other devices connected to device 600, but fails to disclose a camcorder and PDA devices.

The examiner takes official notice that the camcorder is merely a VTR with a camera and wherein the PDA is also a well

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known external device for receiving, storing and transmitting data, such as audio and video images, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Yamauchi by providing additional host devices such the camcorder and PDA, for providing images and/or sound, as is well known and viable hosts, as is obvious to one skilled in the art.

Regarding claims 23-25, Yamauchi fails to particularly disclose providing data processing circuitry for formatting a file system of the large capacity digital storage unit so that it is compatible with a host file system and wherein or to translate a file system/convert or to emulate to a host file system.

The examiner takes official notice that is it well known to provide means to format to a file system and further obvious to format to a compatible format between different storage devices in view of compatibility, even to translate/convert and/or emulate a host device file system, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Yamauchi by incorporating processing circuitry for formatting a storage device of the system, to translate or convert or even emulate to a host, to a compatible format thereby allowing transfers between different devices, as is well known in the art.

Regarding claim 13, Yamauchi utilizes a computer for control of the repository device as one means to control device 600, but, fails to particularly mention, transferring picture image data to a user's computer.

The examiner takes official notice that it is well known to utilize a computer to either provide or receive picture image data to and from another device, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Yamauchi by transferring picture image data to a user's computer, thereby allowing editing on the user's computer of images received, as is well known in the art.

Regarding claim 21, Yamauchi fails to disclose wherein the power source {based on claim 1, directed toward the digital processor and transfer circuitry} is responsive to the memory insert signal.

The examiner takes official notice that it is known in the art that upon insertion of a memory module that the power of the unit receiving, will be response to the entry or insertion and detection of the insertion and cause the unit to power up therefore, it would have been obvious to one skilled in the art

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at the time of the invention to modify Yamauchi by making the power source responsive to the memory insert signal, thereby powering up the system upon newly receiving a memory module, thereby providing a convenience to a user by power up upon the entry of a card to either read what on the card or any other desired operation with the memory card, as is well known.

Regarding claim 22, Yamauchi in view of the filing date, cannot or fails to mention IEEE 1394 port or interface, known to be used to transfer various types of digital data.

The examiner takes official notice that IEEE 1394, is well known, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Yamauchi by incorporating a IEEE 1394 universal digital interfacing means, thereby providing the ability to handle data transfers to and from IEEE 1394 devices, being well known in the art.

Claims 26-44, 46-48 and claims 49-52, 54, 56-93 are analyzed and discussed with respect to the claims above.

Regarding claim 45, Yamauchi further discloses DMA direct memory access (col. 42).

Claim 53 reads on receiving commands thru a user interface and responding to those commands from the user such as from the computer thru a bus interface which can be connected to control the system, which is automatically detected and switched to.

Regarding claim 55, Yamauchi fails to disclose when the repository device 600, is coupled to a host thru a bus (such as the computer or word processor or other user interface device), detecting activity and powering up in response to the activity sensed on the bus.

The examiner takes official notice that the concept of powering from a sleep mode or off mode, by sensing activity on a bus is well known in the art, therefore it would have been obvious to provide the automatic wake upon interacting with one of many types of interfaces available as disclosed and to power up upon any activity from one of the interfaces thru a bus, to provide automatic power up, as is well known in the art.

Contact Fax Information

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
9/19/04

Vincent F. Boccio
VINCENT BOCCIO
PRIMARY EXAMINER